Claim Objections

Claims 35 and 42 were objected to for informalities. Claims 35 and 42 are amended to correct the informalities.

§102 Rejection of the Claims

Claims 25-41 were rejected under 35 USC § 102(e) as being anticipated by Dethloff et al. (U.S. 4,968,873), hereinafter "Dethloff." Applicant respectfully traverses these grounds for rejection.

Claim 25 recites: "creating instructions for an internal script from the personalization data." The Office Action relied on Dethloff column 11, lines 1-27, which recites:

> An interim or temporary memory 209 accepts external data for the time of the checking procedure, when such external data, the PIN and other identifying data, are fed into this memory to be internally checked as to whether they are correct or not. A program memory 217 comprises an into-program 216, a multi-service program 215, an external transaction program 214, an arithmetic calculation program 213 and PIN check program 211. ...A multi-user (M) and variable value (VV) logic 201 is logically adjacent to sub-user PIN program memory 206, variable value program memory 205, internal transaction program memory 204 and display or text program in memory 230. ... Sub-user PINs can be stored and erased under the control of M and VV logic 201. A working memory 224 comprises transaction accounts for the cardholder and sub-users 225, the terms of use for the cardholder and for sub-users 226, the VV transaction account for cardholder and sub-users 227 and the table of different services the card is commissioned for 228.

Thus, Dethloff merely describes that external data is put into memory 209, and transaction accounts are in memory 224. In contrast, all of Dethloff's programs are in program memory 217. Dethloff does not teach or suggest that its programs are created from its external data or transaction accounts. Instead, Dethloff's programs operate on data. This can be see from the following three Dethloff references:

[PIN check program 211] ... first checks whether the PIN inputted by the user is available in the cardholder's PIN storage, and in case it is not, it will then check with the sub-user PIN storage. If the inputted PIN cannot be found in either storage, the logic will start the wrong PIN procedure. If the inputted PIN is found in the sub-user PIN storage, the standard transaction or other program will be started by logic 208. *Dethloff at column 13, lines 36-45.*

[T]he variable value program in memory 205 effects the arithmetic calculation program in memory 213 to convert the amount of original currency by calculating, with the proper conversion factor in memory 222, the amount of selected foreign currency. *Dethloff at column 15, lines 13-17.*

FIG. 11 shows the alternative, when the cardholder can inform him/herself via the info program in memory 216, on the available amount of credit for such operation. FIG. 12 shows the flowchart without the "info" function. *Dethloff at column 14, lines 37-42.*

Thus, Dethloff does not teach or suggest "creating instructions for an internal script from the personalization data," as recited in claim 25 because all the Dethloff programs operate on data instead of being created from data.

Claim 26 further distinguishes over Dethloff. Claim 25, on which claim 26 depends, recites: "A method in a personalization system of processing data for a portable programmed data carrier comprising: ... acquiring personalization equipment characteristics for particular personalization equipment." Claim 26 recites: "transferring the data stream to the particular personalization equipment to issue the data carrier." Thus, applicant's claimed invention describes three elements: a personalization system, particular personalization equipment, and a portable programmed data carrier. Applicant's method in the personalization system acquires characteristics for particular personalization equipment and transfers the data stream to the particular personalization equipment to issue the data carrier.

In contrast to applicant's claimed invention, Dethloff describes only two elements: a card issuing machine and issued cards. The Office Action relied on Dethloff column 15, line 64 through column 16, line 37, which recites in pertinent part:

FIG. 17 is block diagram of the (ViVo) card issuing machine. Besides the elements that are visible from the outside, the machine comprises a processing unit 1701, program memory 1702, interim PIN memory 1703 (which is disposable where there is no stored PIN record), a general visitor file 1704 and a machine journal and audit file 1705. 1708 is an exchange rate storage.

Operations by both the operator and the visitor and the machine function are shown in the flowchart of FIG. 18.

FIG. 19 is a perspective view of a (M-)ViVo card return machine 1801, which accepts at the place of the visitor's departure, the return ViVo card. The machine comprises visitor's display 1802 and, arranged in the visitor's control panel 1807, the "start" button 1806, the "ok" button 1805, the card return slot 1808, the PIN-pad 1804, the visitor's slip printer 1803 and the bank note dispenser 1809.

FIG. 20 is a block diagram of the machine of FIG. 19, including a processing unit 1901, a program memory 1902, an interim PIN memory 1903, the general visitor file 1904, and the machine's journal and audit file 1905.

Thus, Dethloff describes two elements: a card issuing machine and issued cards. In contrast, applicant's claimed invention describes three elements: a personalization system, particular personalization equipment, and a portable programmed data carrier. Hence Dethloff does not teach or suggest an element corresponding to applicant's personalization system. Since Dethloff has no personalization system, it does not teach or suggest a method in a personalization system, as recited in applicant's claim 25. Applicant's personalization system acquires personalization equipment characteristics for particular personalization equipment and transfers the data stream to the particular personalization equipment to issue the data carrier. Dethloff does not teach or suggest applicant's claimed invention because Dethloff does not have a method in a personalization system that transfers a data stream to particular personalization equipment to issue the data carrier since Dethloff only has two elements and not three.

Claim 35 and 38 contain similar elements to those argued above for claims 25 and 26, and are patentable for similar reasons. Claims 26-34, 36-37, and 39-41 are dependent on claims 25, 35, and 38, respectively, and are patentable for the reasons argued above.

§103 Rejection of the Claims

Claims 42-44 were rejected under 35 USC § 103(a) as being unpatentable over Dethloff. Applicant respectfully submits that the claims are patentable over Dethloff for the reasons argued below.

Claim 42 recites: "A computer-readable medium having stored thereon a smart card framework data structure comprising: ... an equipment field containing data representing an identifier for personalization equipment used by a personalization system to program the microprocessor identified by the chip field." Thus, it is clear from applicant's claim that the personalization system is using the equipment field in the data structure to identify personalization equipment that programs the microprocessor on a smart card.

The Office Action admits that Dethloff does not teach a data structure having such an equipment field, but argues that it would have been obvious because in order for the smart card to communicate with a card issuing machine, the smart card must be able to identify the machine first. The Office Action appears to be arguing that an equipment field is inherent in Dethloff.

MPEP § 2112 recites the standard for inherency: "In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art," citing <u>Ex parte Levy</u>, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

First, it is unnecessary for the Dethloff card to identify the issuing card machine because it could be that the Dethloff issuing card machine identifies the Dethloff card instead. Also, applicant respectfully traverses the one-reference rejection and respectfully requests the Examiner to provide a reference that describes such an element. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Second, a smart card identifying a machine is not what applicant is claiming. Instead, applicant's claims recite that a personalization system is using the equipment field in the data structure to identify personalization equipment that programs the microprocessor on a smart card. Thus, the Office Action's argument is in a backwards direction from applicant's claims, and the Office Action's argument contains no personalization system.

Claims 43-45 are dependent on claim 42 and are patentable over Dethloff for similar reasons as those argued above, plus the elements in the claims.

Double Patenting Rejection of Claims Under §101

Claim 1 was rejected under 35 USC § 101 as claiming the same invention as that of claims 1-2 of U.S. Patent No. 5,889,941, hereinafter "'941." Applicant respectfully traverses these grounds for rejection because there is no claim 1 pending in this application; instead, only claims 25-44 are pending.

Claims 35 and 38 were rejected under 35 USC § 101 as claiming the same invention as that of claims 1-11 and 19-23 of '941. Applicant respectfully traverses these grounds for rejection for the reasons argued below.

A double patenting rejection under 35 U.S.C. § 101 is appropriate when the claims of an application are substantively the same as those of a first patent. MPEP § 804. A rejection based on double patenting of the "same invention" type finds support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process...may obtain a patent therefore ..." Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the identical subject matter being claimed twice? MPEP § 804. As set forth in the MPEP, a reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
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Applicant's claim 35 recites "A computer-readable medium having stored thereon instructions" while claims 1-11 of '941 recite: "A method." Thus, they are in different statutory classes. Hence, using the standard set forth in an MPEP, a CD-ROM having appropriate instructions encoded thereon would literally infringe applicant's claim 35, but would not literally infringe the method claims of '941 because a CD-ROM by itself does not carry out method elements. Thus, applicant respectfully submits that there is no double patenting under 35 U.S.C. 101 of applicant's claim 35 over claims 1-11 of '941. Claims 19-23 of '941 recite "A data structure." Again, claim 35 is of a different statutory class than claims 19-23 of '941. Again, using the standard set forth in an MPEP, a CD-ROM having appropriate instructions encoded thereon would literally infringe applicant's claim 35, but would not literally infringe the data structure claims of '941 because a CD-ROM having instructions stored thereon would not literally infringe a data structure, which has data. Thus, applicant respectfully submits that there is no double patenting under 35 U.S.C. 101 of applicant's claim 35 over claims 19-23 of '941.

Applicant's claim 38 recites "A computer system comprising: a processing unit." Again, since claims 1-11 of '941 recite: "A method" and claims 19-23 of '941 recite "A data structure," the claims are of different statutory classes, so there is no double patenting under 35 U.S.C. 101 of applicant's claim 38 over claims 1-11 and 19-23 of '941.

Claim 42 was rejected under 35 USC § 101 as claiming the same invention as that of claims 24-26 of '941. Applicant respectfully traverses these grounds for rejection because claim 42 is of a different statutory class than claims 24-26 of '941. Again, using the standard set forth in an MPEP, a data structure having appropriate fields would literally infringe applicant's claim 42, but would not literally infringe the method and system of claims 24-26 of '941 because a data structure would not literally infringe a method or system. Thus, applicant respectfully submits that there is no double patenting under 35 U.S.C. 101 of applicant's claim 42 over claims 24-26 of '941.

Claim 1 was rejected under 35 USC § 101 as claiming the same invention as that of claims 1 and 10-13 of U.S. Patent No. 6,014,748, hereinafter "'748." Applicant respectfully

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traverses these grounds for rejection because there is no claim 1 pending in this application; only claims 25-44 are pending.

Claim 35 was rejected under 35 USC § 101 as claiming the same invention as that of claims 1 and 10-13 of '748. Applicant respectfully traverses these grounds for rejection because claim 35 recites: "A computer-readable medium having stored thereon instructions" while claim 1 of '748 recites "A method" and claims 10-13 recite: "A system." Again, using the standard set forth in an MPEP, a computer-readable medium having appropriate instructions stored thereon would literally infringe applicant's claim 35, but would not literally infringe the method and system claims of '748. Thus, applicant respectfully submits that there is no double patenting under 35 U.S.C. 101 of applicant's claim 35 over claims 1 and 10-13 of '748.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-371-2103) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
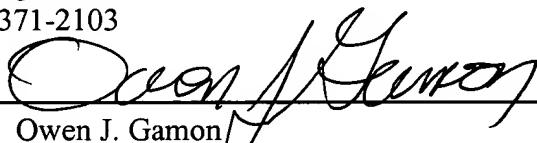
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